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IN THE

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1949.

No. 822.

GEORGE R. ERICSON and CARTER CARBURETOR CORPORATION,

Petitioners,

v.

CLARENCE H. JORGENSEN, CLARENCE H. JORGENSEN, Adm'r. of the Estate of Peter J. Jorgensen, Deceased, and GENERAL MOTORS CORPORATION,

Respondents.

No. 822.

OTTO HENNING and CARTER CARBURETOR CORPORATION,

Petitioners,

v.

CLARENCE H. JORGENSEN, CLARENCE H. JORGENSEN, Adm'r. of the Estate of Peter J. Jorgensen, Deceased, and GENERAL MOTORS CORPORATION,

Respondents.

RESPONDENTS' REPLY BRIEF.

GENERAL STATEMENT.

These cases involve a Petition for Writs of Certiorari in two suits asking this Court to review concurrent Findings of Fact by two courts below, with utter absence of

NOTE: All emphasis in this Brief are ours.

any obvious and exceptional showing of error, or in fact any error whatever. There are no novel questions presented here, nor any question where the decisions of the Courts below are either in conflict with the decisions of this Court or in conflict with the decisions in other circuits. The Petitioners have filed with their Petition an Appendix* to which we will hereafter refer. We are filing herewith an Appendix** containing the Findings of Fact and Conclusions of Law of the District Court and also illustrations of a few of the exhibits contained in the record. We are also filing herewith duplicates of Plaintiffs' physical Exhibit 41, which is the first Olds Six Cylinder commercial choke; each has been sectioned to show its interior, but a drawing showing the interior construction, Plaintiffs' Exhibit 111, is found in the Appendix. The Court of Appeals said as to this choke that it was "substantially like the original," Petition Appendix p. 60.

The Petition, p. 3, describes in a footnote the operation of a carburetor, but it does not describe the device involved in these cases, except by the general statement that it is an automatic choke for a carburetor. It is believed, therefore, that it will be profitable to tell this Court what these cases are really about. To begin with, we want to first quote from Judge Duncan's decision, Petition Appendix pp. 47-48:

> ". . . For many years (as is well remembered by all of us who lived before the modern automotive age) cars were equipped with manually operated chokes."

Of course, this Court is familiar with those manually or hand-operated chokes, but we can limit ourselves here to

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* Hereinafter called Petition Appendix.

** Hereinafter called Reply Appendix—having footnote references to the record.

a device for controlling the air valve. Prior to the Jorgensens' invention a knob on the dash was connected with the air choke valve in the carburetor, which knob when pulled out would restrict or almost shut off the flow of air so that a rich gasoline mixture went into the carburetor for starting. What the Jorgensens did was to disconnect that hand choke and provide a "Robot" which would cause the whole operation to be performed automatically as is, indeed, the case today. We can here again quote Judge Duncan's Finding 18, Reply Appendix pp. 135-136 having reference to the record in the footnote:

> "18. The Jorgensens had given an automatic choke study for a number of years and were jointly working along that line. What they were trying to do was to find means that would serve the requirements necessary to start and to run an automobile engine, particularly when cold, entirely automatically. The early part of 1927 they felt that they had the necessary requirements in mind that would make it possible to make a fully automatic choke, sensing the difference between cranking and running, by employing a suction device and a thermostatic metal to control or modify either the fuel or the air side of the carburetor."

The first two illustrations in the Reply Appendix PX 9 and PX 10 are photographs of Jorgensens' choke controlling mechanism as connected with a Stromberg carburetor. Judge Duncan in his Finding 10, Reply Appendix 132-133, described this as a choke controlling mechanism comprising (we have inserted the numbers found on PX 9 and PX 10):

> ". . . (1) A heat responsive motive device in the form of a thermostat 6 which is of spiral form and located to be heated from the exhaust manifold E; (2) A suction responsive device in the form of a bellows 1

which itself forms a spring and which is connected by pipe connection 2 to the intake manifold I so as to respond to the changes in the suction therein; (3) A joint connection 4, 5, 3, from the thermostat and the bellows to the choke valve of the carburetor, viz., to the operating arm of the choke valve shaft 9, through a link 7 to the end of the thermostat, through the thermostat shaft 4 to an arm 5 thereon and through that arm to the bellows 1."

The above construction will act automatically in the following manner: When the engine is cold the choke valve will be closed; as soon as the engine begins to run under its own power the bellows connected with the intake manifold will partially collapse so as to partially open the choke valve; as the engine continues to run it heats up, the thermostat completes the opening of the choke valve which becomes fully open when normal temperature is reached, and thereafter the choke valve will remain open as the engine continues to operate at normal temperature. This cycle of operation is completed every time the engine is started when cold and warms up when running after it is started. The device is, therefore, entirely automatic. A short, practical demonstration can be had with Jorgensens' first commercial Olds device, Plaintiffs' Ex. 41, of which a number have been filed. By simply holding a match or cigar lighter against the thermostat, the movement can be seen. The bellows will also collapse when moved with the thumb nail, thus assimilating the action of suction.

We need not repeat the history of this invention in detail, because it is given in the Decisions of the Courts below and in Judge Duncan's Findings of Fact with foot note references to the record. We want to, however, observe that the Jorgensens were very particular and anxious to develop something which would meet all conditions with

various carburetors. They therefore first tried the mechanism out on a Studebaker car provided with a Schebler carburetor, and after Studebaker had changed to a Stromberg carburetor, they tried it out with that carburetor. The demonstrations extended from October 1928 to July 1930, that is through two Winters, two Summers and intervening Falls and Winters, and all that under weather conditions in Chicago, South Bend and in between. That the Jorgensens found the solution is evidenced by the fact that the first Jorgensen commercial choke was found by the Court of Appeals, Petition Appendix 60 to be "substantially like the original." A mere comparison of the photographs PX 9 and PX 10 in the Appendix and with the small physical exhibit PX 41 will show that. It is simply a matter of equivalent linkage and leverage connections.

The Jorgensens did not hide their choke controlling mechanism under a bushel, but they freely consulted those skilled in this art, namely: Paton who in 1928 was in charge of general experimental and development work at Studebaker corporation at South Bend, Indiana, R. I. 317; Kyser who was then in the engineering department of Studebaker Corporation, R. I. 336; and the practical and intelligent automobile mechanic Williams, who was then doing repair work at the garage where the Jorgensens kept the automobile, R. I. 291. In July 1930 the Jorgensens terminated their connection with Dole Valve Company and established a laboratory of their own. However, we all know what had then happened, namely, the depression had started in the Fall of 1929 and for the succeeding years the automobile sales dropped to almost a vanishing point. The Jorgensens, however, as early as 1930 contacted the Wilcolator Company and entered into an agreement with that company to manufacture the Jorgensens' choke-controlling mechanism, but that Company had financial reverses as early as 1931. The Jorgensens, moreover, proceeded to redesign their device to get the cost down, as will be seen

from the 1934 device, Plaintiffs' Ex. 41 which sold for about 50¢. Jorgensen visited a number of automobile companies in 1930 and 1931 to interest them. The application was filed on January 8, 1932, but well within two years from anything which can be called a public use under R. S. 4886, 35 USC 31.

After the Jorgensens had filed their application, then the real trouble began. Although the Patent Office as early as six months after the filing of their application had found twenty-two claims allowable, the Jorgensens were immediately projected into a large number of interferences beginning in February 1934. Of course, during all that time the application was held up and it is still being held up, because of these proceedings. Finally, General Motors Corporation took over the burden and therefore appeared as party plaintiff before the District Court.*

As this Court knows interferences are long and drawn out. The actual testimony stage is proceeded by numerous motions and preliminary proceedings. The result was, therefore, that the testimony before the Patent Office is sometimes not even proceeded with until long after the filing of an application.

The testimony in these cases was taken in 1943 and 1944 during War time and, of course, to get witnesses to testify who like Kyser, were on War work, was difficult; in fact, Kyser's testimony was taken on a Sunday and everything was hurried along. The result was the exceedingly technical decision of the Patent Office finding numerous faults with the method of introducing evidence with the resultant decisions against the Jorgensens.

Respondents and their counsel fully realized the burden on Respondents to establish their case, particularly after

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* For a more complete statement see p. 17, infra.

all that time had intervened although through no fault of theirs, but due to the slowness of the proceedings in the Patent Office during the prosecution of the application and particularly in interference proceedings. While Jorgensen produced in court his original choke controlling mechanism physical exhibit #13, the utmost care was taken in presenting the evidence. In the case of each witness he was asked to describe the construction and operation of what he saw before he was even faced with the physical exhibit (it was even covered up): Kyser R. I. 347-349, Paton R. I. 319-325, Williams R. I. 297-302. Before their attentions were directed to the physical exhibit, Kyser made a free-hand sketch PX 123, R. II. 699 and so did Paton PX 120, R. II. 691. The witnesses, therefore, did not testify from something before them, but from memory, and all were highly skilled in this art.

During the taking of the depositions before the Patent Office pains were taken to again demonstrate, in December 1943 and January 1944, the physical exhibit PX 13 with a Schebler carburetor and Studebaker car like those with which such physical exhibit was originally demonstrated in 1928 and 1929. The later demonstrations were conducted when the outside temperature was 22° F.; the last one before counsel for the opposing parties in three of the interferences, including even the Petitioner Ericson, all with complete success, and there was no cross-examination, R. I. 399 by Petitioners.

R. S. 4915, 35 USC 63.

The Statute is quoted in the Petition Appendix p. 2. Its legislative history was traced by this Court in **Hoover Co. v. Coe**, 325 U. S. 79, 84-87, except that the last two sentences were not discussed. District Judge Duncan in his Opinion (Petition Appendix p. 43) shows that these two sentences were added by the amendment of March 2,

1927, Chapter 273, Sec. 11, 44 Stat. 1336. It is to be noted that that was after Morgan v. Daniels, 153 U. S. 120, decided in 1894 where the Statute as then worded is quoted at page 121.

Before the 1927 amendment this Court and Justices of this Court considered that Statute and particularly with reference to what evidence is necessary or permissible in a suit under that statute.

Butler v. Shaw, 21 F. 321, C. C. Mass., was decided by Justices Gray and Nelson; Justice Gray said, p. 327:

> ". . . the statute contains no provision requiring the case to be heard upon the evidence produced before the commissioner, or restricting the effect of the decree; and, as has been held in this and other circuits, the court may receive new evidence, and has the same powers as in other cases in equity."

Butterworth v. Hoe, 112 U. S. 50, involved a construction of R. S. 4915. This Court said, p. 61:

> "This means a proceeding in a court of the United States having original equity jurisdiction under the patent laws, according to the ordinary course of equity practice and procedure. It is not a technical appeal from the Patent Office, like that authorized in § 4911, confined to the case as made in the record of that office, but is prepared and heard upon all competent evidence adduced and upon the whole merits. Such has been the uniform and correct practice in the Circuit Courts. Whipple v. Miner, 15 Fed. Rep. 117; Ex parte Squire, 3 Ban. and A. 133; Butler v. Shaw, 21 Fed. Rep. 321."

Hoover v. Coe, 325 U. S. 79, 83, supra, decided after the 1927 amendment to the statute, distinguishes between a

proceeding by appeal under R. S. 4914, 35 USC 62, and by a proceeding under R. S. 4915, this Court said, p. 83:

> "It is evident that alternative rights of review are accorded an applicant—one by appeal to the United States Court of Customs and Patent Appeals, the other by bill in equity filed in one of the federal district courts. In the first the hearing is summary and solely on the record made in the Patent Office; in the other a formal trial is accorded on proof which may include evidence not presented in the Patent Office."*

The distinction was also made by the later Mr. Justice Rutledge, with whom sat the later Chief Justice Vinson, in **Hemphill Co. v. Coe**, 121 F. (2d) 897, CCA D. C. 898:

> ". . . The remedies are alternative and mutually exclusive, though differing in that the equity suit affords an opportunity for introduction of new evidence which is lacking on the appeal."

In the case of **Boucher Inventions v. Sola Elec. Co.**, 131 F. 2nd 225, the later Mr. Justice Rutledge, with whom again sat later Chief Justice Vinson, makes the following distinction:

> ". . . While the 4915 suit is de novo and permits introduction of evidence not presented to the Patent Office, it does not contemplate the suppression or the withholding of evidence so readily available and of such importance as was Exhibit AR or oversight of such glaring proportions . . ."

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* This Court cited Butterworth v. Hoe, 112 U. S. 50, 61, in a footnote.

THE QUESTIONS PRESENTED.

The questions presented in the Petition p. 13, are not novel questions; nor do they involve any questions of law on which the Decision and Judgment of the Court of Appeals for the Eighth Circuit in this case are in conflict with the decisions of this Court or with decisions in other circuits, and Petitioners have not so shown.

(1) The Patent Office Record Not Offered in Its Entirety.

R. S. 4915 does not require that the entire record before the Patent Office be introduced before the District Court. That was not only the view of the justices of this Court before the 1927 amendment, but was made explicit by the 1927 amendment providing for the admission of that record "in whole or in part" "or the parts thereof." The trial being one de novo, left it to the parties "on motion of either party" to add such parts of the record before the Patent Office as they might deem material; that is what actually happened in this case.

Defendants' Ex. 44, R. II. 921-925, is a list of Respondents' witnesses and the exhibits before the Patent Office. The depositions of all of the witnesses were offered except those of Jorgensen, Kyser and Morton, who testified in open Court, but all three were cross-examined by Petitioner's counsel. Thereafter, Petitioners proceeded to offer such parts of the Patent Office depositions as they saw fit; of Jorgensen, R. I. 258-268, and of Kyser, R. I. 399-409. Thereafter Respondents offered such additional parts of the Patent Office depositions of Jorgensen R. I. 271-2, as they saw fit. In other words, Petitioners and Respondents proceeded in the manner contemplated by R. S. 4915 and offered such parts of the deposition before the Patent Office as they saw fit. Petitioners did

not call upon the Respondents to produce any other parts of the record before the Patent Office.

Moreover, the position of Petitioners' counsel is insincere for the following reasons: Petitioners have not produced all of their evidence before the Patent Office. As appears from the proceedings before the District Court, R. I. 427-450, Petitioners only introduced some of their depositions and then only parts of the depositions were actually offered, and Respondents' counsel called the attention of the Court to that very thing, R. I. 460. That is particularly pertinent here, because in their Petition, p. 5, Petitioners now rely upon "Ericson presented evidence both documentary and oral . . . showing diligence from his conception in October, 1929, until his filing date of April 24, 1930." As noted by Respondents' counsel, R. I. 460, Ericson's depositions before the Patent Office were not even offered; indeed, it was Respondents who called Ericson R. I. 451-459, and examined him upon the sufficiency of the disclosure in the Ericson application of April 24, 1930, now relied upon, Petition p. 5.

The decisions relied upon on this question, Petition p. 4, do not support Petitioners' position. Whether or not the 1927 amendments to R. S. 4915 has or has not affected the applicability of the doctrine of Morgan v. Daniels, 153 U. S. 120,* to actions under that statute, is not material, because the District Court found in his opinion, Petition Appendix p. 50:

> ". . . A careful weighing of all the evidence which was presented to the Board of Interference Examiners and which has been submitted to this court carries thorough conviction which is required by the law, that is, that plaintiffs conceived and reduced to prac-

* Morgan v. Daniels was presented to the District Court on the depositions before the Patent Office; there was no additional testimony, nor did any witness testify in open court.

> tice their patent in 1928 and 1929 prior to the filing of defendant's application."

That finding was affirmed by the Circuit Court of Appeals, Petition Appendix p. 55.

Victor Co. v. Brunswick Co., 8 F. 2d 41, CCA 3, was a suit under R. S. 4918, 35 USC 66, involving an interference of **two patents** in which the District Court held "the patents of both parties invalid." The decision simply contains an observation that the complete records of the Patent Office and Court of Appeals of the District Court of Columbia were not before the District Court but that, p. 41:

> "The learned District Judge held that the testimony before him was not sufficient in character and amount to carry thorough conviction that the conclusion of the Court of Appeals was erroneous."

Buck v. Ooms, 63 Fed. Sup. 715, D. C. D. C., did not decide that the records before the Patent Office must be introduced.

Abbott v. Coe, 109 F. 2nd 449, C. C. A. D. C., was a case where the Court held p. 451:

> ". . . The question for us is not whether in our opinion there was invention, but whether the finding that there was none is consistent with the evidence."

Mississippi Valley Barge Co. v. United States, 292 U. S. 282, involved an entirely different statute than is R. S. 4915, providing for a trial de novo and leaving it to the parties to offer the record in the Patent Office "in whole or in part" or "parts thereof." The case was submitted on affidavits which the District Court found, 4 F. Supp. p. 747, "afford only an incomplete picture of the situation."

(6) **Additional Witnesses Not Before the Patent Office.**

This is taken up out of turn because it is related to Question (1). Question (6) relates to the additional testimony of Paton and Williams, not before the Patent Office. We have seen from a consideration of R. S. 4915, that even before the 1927 amendment to the statute, a plaintiff in a suit under that statute, had the right to offer additional evidence and that this was made explicit by the 1927 amendment. The only exception was that the evidence should not have been suppressed or withheld. The District Court fully understood that and he specifically found in his Opinion, Petition Appendix p. 44:

> "There is no evidence here of withholding or concealing the testimony of the witnesses from the Board." . . .
>
> "The witnesses were available and their testimony could have been obtained for submission to the Board; but there is no substantial suggestion that their testimony was concealed or deliberately withheld. The war was on and those engaged in mechanical production were busy. Plaintiff testified, and it was undisputed, that he had not talked to these witnesses for many years prior to the hearing."

Those findings of fact were not disturbed by the Court of Appeals. Jorgensen testified R. I. 221, that at the time of the taking of his deposition before the Patent Office he did not remember Williams' name, but he did so at the trial before the District Court, R. I. 221. As to Paton, Jorgensen testified that at the time Jorgensen gave his deposition before the Patent Office he was not too clear of what he had showed Paton. Further that the War was then going on; he had difficulty talking to people about the matter at that time, but that he did not conceal his device from anybody, R. I. 222-223.

The decisions cited Petition p. 17, do not support Petitioner that there is a conflict in the decisions in the various circuits. Barrett v. Koppers, 22 F. 2, 395, CCA 3, while containing a broad statement, actually involved suppression and withholding of evidence, in that witnesses were instructed not to answer questions on the very matter later offered; that was made clear in the last decision in that same circuit; Minnesota Co. v. Carborundum Co., 155 F. 2d 746, CCA 3. Greene v. Beidler, 58 F. 2d 207, CCA 2, was distinguished from in Dowling v. Jones, 67 F. 2d 537, CCA 2, which also distinguished suppression as against slackness in preparation. Bouchers Inventions v. Sola Elec. Co., 131 F. 2d 225, CCADC, we have shown involved "suppression or withholding of evidence". Perkins v. Lawrence Sperry Aircraft Co., 57 F. 2d 719, DCED N. Y. was not approved in Dowling v. Jones, supra. Wright v. Runge, 31 F. Supp. 844, DCDC, actually followed Bouchers Inventions v. Sola Elec. Co., supra, although it does not cite it. O'Donnell v. United Shoe Machinery Corp., 2 F. Supp. 178 DC Mass. involved an actual reservation of full presentation in the previous case.

From the above it will be seen that there is no conflict between the decisions in the various circuits, including even the District Courts as to the question here involved, and none of the final decisions in the other circuits are contrary to any decisions of this Court. As noted above, the District Court, who saw and heard the witnesses, specifically found, "there is no evidence here of withholding or concealing the testimony of the witnesses from the Board."

(2) **Abandonment and Forfeiture.**

The Court of Appeals specifically found Petition Appendix p. 60:

> ". . . The Jorgensens did not delay unduly in applying for patent. Soon after reducing their invention to practice they contracted to have patent applied for and for manufacture and commercial exploitation and upon failure of the other contracting party to proceed they took other steps to the same end and actually applied well within two years . . ."

The facts giving dates are more fully set out in the District Court's finding 14; see Reply Appendix R. I. 134, with footnote references to the record.

This is simply an ordinary patent case in which an inventor has taken pains to see that his invention has been fully demonstrated in this case as applied to different carburetors; thus first, to a Schebler carburetor from Christmas 1928 to Christmas 1929 and then to a Stromberg carburetor from Christmas 1929 to July 1930. This Court approved such a practice in Elizabeth v. Pavement Co., 97 U. S. 126, p. 137, and in Beedle v. Bennett, 122 U. S. 711. R. S. 4886, 35 USC 31, at that time even permitted an actual public use of two years before applying for a patent and that statute specifies that the subject-matter must have been "proved to have been abandoned." The law, therefore, does not require an applicant to apply for a patent as soon as he has made or even demonstrated it, and clear evidence of an intention to dedicate an invention to the public is indispensible to establish abandonment; Ide v. Trorlicht Co., 115 F. 137, 144 CCA 8. Furthermore, that defense was not raised in the answer R. I. 6, etc. 12, 18 etc., and 25. The defense of an abandonment is an affirmative defense which must be pleaded and proved; Electric Battery Co. v. Shimadzu, 307 U. S. 5, 16.

The decisions cited Petition p. 15 do not apply here.

In **Woodbridge v. United States**, 263 U. S. 50, Woodbridge had filed his application in the United States in 1852 and the Patent Office was ready to issue the patent forthwith.

However, Woodbridge wrote the Commissioner of Patents to hold up the issue of the patent and then Woodbridge did nothing for over nine years. The purpose was obviously to extend a monopoly for over nine years after filing. Of course, that was a case of deliberately withholding the application in the Patent Office, which this Court said involved forfeiture and not simply abandonment.

Wirebounds Patents Co. v. Saranac Corp., 65 F. 2d 904, CCA 6, was like the Woodbridge Case. As appears p. 905, the applicant filed an application including method claims in 1904, but the method claims were cancelled in 1905 and were not reinserted until 1912 when patentees made the method claims by a divisional application with the patent issuing in 1915. In that case, as in the Woodbridge Case, the applicant had deliberately held the application in the Patent Office for a period of seven years without doing anything about the canceled claims.

The Petitioners complain, Petition pp. 4, 5 and 16 that the Ericson patent will expire on June 27, 1950 and that the Henning patent will expire on June 3, 1964, and that a grant of a patent to Respondents will extend a monopoly. The answers to this are: First, an applicant for patent is not charged with delays occurring in the Patent Office; United States v. Bell Telephone Co., 167 U. S. 224, 247, 250, recently affirmed in Hartford Empire Co. v. United States, 323 U. S. 386, 432, 433. Second, R. S. 4904, 35 USC 52, provides for interferences not only with a pending application, but "with any unexpired patent". Third, a patentee of a patent inadvertently issued by the Patent Office is not vested with any "property right of which he could not be deprived in an interference proceeding"; Owen v. Hymann, 12 F. 2d 173, CCA D. C., certiorari denied. Fourth, the Jorgensens did not delay the prosecution of their application in the Patent Office, as appears from the following:

DX 46, the complete Jorgensen file wrapper and contents shows the following: After the filing of the application on January 8, 1932, the Patent Office did not reach the application for action until almost six months later, namely, June 11, 1932, Paper 3, and, as noted, nine claims were found allowable, but the rest were rejected. After amendment within the statutory period, Paper 4, about four and one-half months later, on April 20, 1933, Paper 7, the Patent Office again reached the case and then found twenty-two claims allowable. Then about a month later, June 2, 1933, Paper 8, the Jorgensens were informed that there were nine claims in other pending applications and asked Jorgensens to copy the same into their application, which they did within five days, Paper 9. Nevertheless, the Jorgensens made another amendment on October 17, 1933, Paper 12, replying to the Patent Office action of April 20, 1933, and a Supplemental Amendment was filed on October 30, 1933, Paper 13. On February 14, 1934, Papers 14, 16, 18, 20 and 22, the Jorgensens' application was projected into five interferences. On August 31, 1935, Paper 28, a party Shaff was admitted to one of the above interferences. On September 31, 1935, Papers 30, 33 and 35, the Jorgensens' application was projected into three additional interferences. On April 21, 1938, the Jorgensens' application was projected into an interference with the Ericson patent 1,915,851, Paper 46 (subsequently dissolved); on June 4, 1940 into an interference with the Henning application 575,577, now patent 2,421,733, Paper 53; and on February 12, 1943 with an application of Ericson 378,426 for reissue of patent 1,915,851, now Reissue patent 22,472, Paper No. 63.

Of the claims allowed on April 20, 1933 before the Jorgensen application was projected into five interferences on February 14, 1934, the following are representative:

> "9. In an internal combustion engine having an intake and a carburetor having an air valve, the com-

bination of pressure responsive means for controlling the valve, pressure connections between said means and the engine intake, and thermostatic means for varying said connections to alter the operation of said means."

"29. In combination, an intake pipe, a carburetor connected thereto, an air valve for said carburetor, a pneumatic motor actuated by suction in the intake pipe, and a yielding thermostat forming a connection between said motor and said valve."

It will be apparent that the above are typical claims covering Plaintiffs' Exhibit 13, the Studebaker choke controlling mechanism. The allowance of those claims has never been withdrawn. However, since February 14, 1934 the Jorgensen application has been held up in the Patent Office until the interferences could be terminated, and even now by the withholding of the mandates of the Court of Appeals and by these petitions.

On the part of Petitioners, however, they have insisted upon the issuance of their patents without awaiting the decisions of a higher tribunal than the Board of Interference Examiners; for Petitioners demanded and on April 9, 1946 had issued to them the Ericson Reissue patent Re 22,742, R. II. 863, with a claim involved in this proceeding. Even after the trial of these causes, in the District Court in May, 1947, Petitioners did not await the decision of that Court, but on June 3, 1947 had issued to them the Henning patent 2,421,733 R. II. 905, with five claims involved in this proceeding. Petitioners seek to hold on to their patents while asking this Court to hold that no patent should issue to Respondents.

(3) Presumption by Reason of Delay in Filing Application.

On this question, Petition p. 13, no decisions are cited. As we have, however, shown under (2) supra, the Jorgensens had the right to continue their demonstrations, first with a Schebler carburetor and second with a Stromberg carburetor, which they did. Where there has been a reduction to practice, as found by the District Court, affirmed by the Court of Appeals, there is no burden of diligence in filing an application following the reduction to practice: Brydle v. Honigbaum, 54 F. 2d 147, 149, CCPA; Bowers v. Valley, 149 F. 2d 284, 287, CCPA; Sinko Co. v. Automatic Corp., 157 F. 2d 974, 976-978, CCA 2. The sole prerequisite of R. S. 4886, 35 USC 31, is that there shall have been no public use and no abandonment, both of which must be proved by a defendant.

(4) The Doctrine of Morgan v. Daniels, 153 U. S. 120.

As we have shown, the District Court fully recognized what this Court said in Morgan v. Daniels, see Petition Appendix pp. 45 and 57. However, here we have the following definite finding of the District Court Petition Appendix 50:

> ". . . A careful weighing of all the evidence which was presented to the Board of Interference Examiners and which has been submitted to this court carries thorough conviction which is required by the law, that is, that plaintiffs conceived and reduced to practice their patent in 1928 and 1929 prior to the filing of defendant's application."

That certainly is a finding coming well within Morgan v. Daniels. While the Court of Appeals quoted from that finding, Petition Appendix p. 55, that Court only found it necessary to discuss the application of the Jorgensens' choke controlling mechanism to a Stromberg carburetor

during the Winter of 1929 and 1930, Petition Appendix p. 58, and specifically "before Christmas 1929", Petition Appendix 59.

The evidence at the trial before the District Court was complete. Disregarding for the moment Jorgensen's testimony, Respondents produced three witnesses as to whom the District Court said, Petition Appendix 50:

> "As heretofore stated, all of the witnesses were engaged in the automobile industry and interested in its development. They were men of experience in their field and their integrity is unquestioned except to the extent that their memories could not be expected to retain the facts so long a time."

None of these witnesses were General Motors employees or connected with General Motors, in fact, the opposite is true. Kyser at the time of the trial was Superintendent of Manufacturing of the Studebaker-Pacific Corporation with whom he had been connected since 1926, R. I. 335; this Court can take judicial notice of the fact that the Studebaker corporation is one of the active competitors of the General Motors Corporation. Paton was at the time of the trial a Consulting Engineer, R. I. 317; after leaving Studebaker Corporation in 1932 he was connected with Packard Motor Co. until 1942 as Experimental Engineer, then as Chief Engineer and thereafter as Consulting Engineer on the engineering staff of Ford Motor Co. He was only with General Motors from 1942 to 1944, on a wartime assignment, returning in that year to Packard as director of Automotive Engineering, R. I. 318. Williams is in the automotive garage business and has never been connected with General Motors Corporation, R. I. 291.

This is not a case where we are simply relying upon oral evidence to establish Jorgensens' priority. We are relying upon a physical exhibit, Jorgensens' Ex. 13,

which had been demonstrated by Jorgensen to Kyser, Paton and Williams from December 1928 until August 1930; which was demonstrated inter partes in January, 1944, at a temperature of 22° F., and which was later produced in Court. The date is established by Jorgensen's acquisition of the 1928 Studebaker car, whose purchase was established by Plaintiffs' Ex. 5, R. II. 499, stipulated R. I. 409. The entire history of that physical exhibit is given briefly by Judge Duncan in his Decision Petition Appendix 49, but is more fully set out in the District Court's Findings 10, 11, 12, 13 and 17; see Reply, Appendix pp. 132-135.

It is well settled that there is a difference in the quantum of proof required where an original physical exhibit has been produced in Court and where it has not been so produced; D. W. Bosley v. Wirfs, 30 F. 2d 667, 669, CCA 8. Here the date of the beginning of the Jorgensens' automatic choke was established by the purchase of the automobile in October, 1928, to which the mechanism was immediately applied.

Petitioners seek to overcome that evidence by calling attention to so-called "contemporaneous documents" Petition p. 13. These are a Memorandum by Jorgensen, Plaintiffs' Ex. 14, referring to a dash-pot and a solenoid, Plaintiffs' Ex. 22, a mere adjustment of the choke-controlling mechanism from the dash; and finally Defendants' Ex. 45 of December 12, 1931, a cold room test with something which Jorgensen testified was "another unit", R. I. 272-273. All of those are set out in Judge Duncan's Findings 10, 11, 12, 13 and 17, Reply Appendix pp. 132-135 and were additionally discussed in the Court of Appeals Decision, Petition Appendix 59, 60, where the Court refers to the following:

> "... In the years 1934 and 1935 some three or four hundred thousand units of their device, substantially like the original, were turned out."

That particular 1934 choke is illustrated in Plaintiffs' physical Exhibit 41, and by a drawing, Plaintiffs' Exhibit 111; from these it will be seen that it is actually as the Court of Appeals said "substantially like the original", Plaintiffs' Ex. 13. That commercial choke does not employ a dash pot, a solenoid or an adjustment from the dash, but the simple combination of a thermostat and a bellows.

The cases of United States v. Gypsum Co., 333 U. S. 364, and Electro Metallurgical Co. v. Krupp Nirosta Co., 33 F. Supp. 324, cited by petitioners, are distinguished on their facts. The decisions below in the present case are no more in conflict with Electro Metallurgical Co. v. Krupp Nirosta Co., than they are in conflict with any other R. S. 4915 interference case in which one party prevails; nor are they any more in conflict with United States v. Gypsum Co., than with any other case in which an appellate court reverses a trial court on mixed question of law and fact. The courts in those cases laid down no general rule that oral testimony should be ignored, particularly where that testimony is given by competent, disinterested witnesses. Furthermore, respondents in the present case, as has been discussed above, rely upon the most convincing of contemporaneous evidence, the actual original device itself.

(5) **No Permanent Idea of Elements.**

It has not been shown that question (2) really involves a question of which this Court will take notice, for it involves a question of fact, and no decisions have been cited to support Petitioners' position. The only discussion is on Petition p. 9. The Jorgensens' choke-controlling mechanism comprising a thermostat and a suction device, such as a bellows, was certainly permanent, for the commercial device of 1934. Plaintiffs' Ex. 41 is actually "substantially

like the original" as found by the Court of Appeals, Petition Appendix p. 60. The contention that the particular device of Plaintiffs' Ex. 13 is not illustrated in the application is not material because the Patent Office specifically found R. II. 475 that the Studebaker device embodied the subject-matter of the claims, and that was confirmed by Judge Duncan's Findings 11 and 13, Reply Appendix pp. 133 and 134, containing the above record citation in the foot-note; while Judge Duncan's Decision, Pet. Appendix 38, in his Finding 6, specifically found that "the common subject-matter of the claims embodied in the interference proceedings were determined by the Patent Office."

(7) **Priority of Ericson.**

This case involves questions of fact and it does not involve any question which will be noticed by this Court where, as in this case, there are concurring findings of fact by the two courts below, with total absence of any very obvious and exceptional showing of error; Graver Mfg. Co. v. Linde Co., 336 U. S. 271, 275. Question (7) was not discussed in the Reasons relied upon for the allowance of the writ. However, Petitioner p. 5 refers to an alleged conception in the Fall of 1929 and an Ericson application of April 24, 1930, on which Patent #1,915,852 issued June 27, 1933, and also "Ericson presented evidence, both documentary and oral." We want to note the following: The Board of Interference Examiners made the following Finding with reference to Ericson, R. II. 477:

> "However, we believe that his (Ericson's) record adequately establishes conception of the invention in issue not later than the Fall of 1929, but no reduction to practice prior to his filing date."

The Ericson applications listed in that decision R. II. 463, are Serial No. 573,418, filed Nov. 6, 1931 and Serial No. 372,428 filed December 30, 1940. Those are the two

applications which are listed in Defendants' Answer in the Ericson Case, R. I. 20. Neither the Patent Office decision nor the Answer, even mention the Ericson application filed April 24, 1930. With reference to Ericson "presented evidence, both documentary and oral," we have previously noted that Ericson did not testify on behalf of Petitioners before the District Court and that we called attention to that fact R. I. 460.

As to the application of the Ericson patent, 1,915,852, of application filed April 24, 1930, Defendants' Exhibit 37, R. II. 823, is a composite of the Ericson patent 1,915,852, showing R. II. 827-833 that a large part of the patent comprises amendments from November 1930 to May 1933. Respondent called Ericson for cross-examination R. I. 451-459 on those amendments in that patent and in a preceding patent. On that cross-examination, after the Petitioners had successfully blocked inquiry into an earlier Ericson application and patent R. I. 451-457, Ericson admitted R. I. 457-459, that many of the things listed as having been added by amendment are of importance and even necessary for the device of that patent to function; but Ericson did not even attempt to show that those things were contained in the application as filed. Such amendments must be disregarded and render the patent invalid. Schriber-Schroth v. Cleveland Trust Co., 305 U. S. 47.

The District Court made a finding in his Decision Petition Appendix 49-50 as follows:

> "Defendant does not contend that his patent was reduced to practice prior to the filing of his application. The Patent Office Tribunal gives to Ericson the Fall of 1929 as the earliest date of conception. That is unimportant as there was no reduction to practice by Ericson."

That was included in the District Court's Finding 16, Reply Appendix p. 135. Of course, the whole thing was

unimportant, because the District Court found in his Decision Petition Appendix 49, 50, that the Jorgensens had actually demonstrated their choke-controlling mechanism, Plaintiffs' physical Ex. 13, with a Schebler carburetor from October 1928 to Christmas 1929, and with a Stromberg carburetor from before Christmas 1929 to July 1930; and these were specifically included in the District Court's Findings 10, 11, 12, 13 and 14, Reply Appendix pp. 132-134. The Court of Appeals affirmed the District Court as to those Findings Petition Appendix p. 55 and specifically as to the demonstration with a Stromberg carburetor from sometime before Christmas 1929 and through the Winter of 1929 and 1930, Petition Appendix 58 and 59.

The Petition pp. 11 and 12 refers to some correspondence between Ericson and Dole Valve Company in December 1929 "regarding thermostatic metal." Now the use of a thermostat per se for controlling a choke valve was not new with Ericson in December 1929. The Jorgensens had obtained a patent #1,701,779, Plaintiffs' Ex. 115, R. II. 657, issued February 12, 1929, on an application filed June 12, 1925, which shows in Figure 7 and 7A a thermostat 20c described R. II. 662 right, to control even an air choke valve, although not in combination with a suction motor, such as a bellows. Moreover, the Gardner patent 1,285,115, R. II. 707, issued Nov. 19, 1918, also showed the employment of a thermostat 13 per se for controlling the fuel valve of a carburetor. What this case involves is the combined action of a thermostat and a suction device. On that combination the Jorgensens had demonstrated their invention from October 1928 to August 1930; and that was later reproduced in the commercial automatic chokes.

CONCLUSION.

It is respectfully submitted that the Petitions in these cases do not involve any novel questions, nor any question on which the decisions of the Court of Appeals for the

Eighth Circuit are in conflict with the decisions of this Court or with decisions in other circuits. These cases are the ordinary patent cases in which the decision of the Court of Appeals for the Eighth Circuit affirms the decision and findings of the District Court.

Respectfully submitted,

JOHN H. BRUNINGA,
Attorney for Respondents.

St. Louis, Missouri,
June 28, 1950.

I hereby certify that three copies of the above Reply and of the Appendix have this day been served on the Attorneys and Counsel for Petitioners.

John H. Bruninga.

FIL
JUL 20
CHARLES ELMOR

IN THE

Supreme Court of the United States

October Term, 1950.

No. 74.

ERICSON, HENNING, ET AL.,
Petitioners

v.

JORGENSEN, ET AL.,
Respondents

PETITIONERS' REPLY TO RESPONDENTS' REPLY BRIEF.

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Respondents.

REPLY OF PETITIONERS TO RESPONDENTS' REPLY BRIEF.

Respondents May Not Effectively Deny That the Purpose and Designed Result of the Conduct of the Jorgensens Were Unduly to Postpone the Time When the Public Could Enjoy the Free Use of the Alleged Invention.

Approximately 40 years will elapse between 1928, the date Respondents assert the Jorgensens conceived and reduced to practice their alleged invention (R. I. 137, Par. VI) and 1967 or 1968, the date of the expiration of the patent authorized by the judgments of the Court below.

Approximately 33 or 34 years will elapse between the years 1934-1935, the dates when Respondents assert 300,000 or 400,000 units of their alleged device were manufactured and sold (Respondents' Reply Brief p. 21), and 1967-1968, the date of the expiration of the patent authorized by the Court below.

At page 17 of their Reply Brief, Respondents seek to make the Patent Office the scapegoat for the acts, purposes

and delays of the Jorgensens which would impose upon the public a further patent monopoly for the full period of 17 years after the expiration of Ericson's Patent Re. 22,742 on June 27, 1950 (R. II, 881). But, the record remorselessly exposes Respondents' attempt so to shift the responsibility for the delays and avowed purposes of the Jorgensens (R. I, 265).

Respondents' (the Jorgensens) patent application was not filed until January 8, 1932 (R. II, 463), more than 3 years after their alleged device was assertedly reduced to practice.

The claims involved in these actions were not presented to the Patent Office until 1939 [1]-1942 [2]-1943 [3]—11 to 15 years after 1928 and 5 to 8 years after Respondents assert that several hundred thousand units of their alleged device had been put into commercial use in 1934-1935 (Respondents' Reply Brief p. 21).

Those facts—unchallenged by Respondents—definitely mean either that the Jorgensens' experiments when laid aside at the end of July 1930 (R. I, 120) had been unsuccessful, as is divulged by PX 14 (R. II, 507) and evinced by PX 22 (R. II, 531) and DX 45 (R. II, 929)—or, that the Jorgensens were deliberately delaying the issue of a patent so that its term and monopoly would reach forward into the future to include a much more commercially lucrative period than existed at the time they assert they reduced to practice their alleged invention (R. I, 265). Indeed, that is disclosed and confirmed by Mr. Jorgensen's own avowal which divulges both that "additional experimental work had to be" done, and that it was the Jorgensens' intention to dawdle until "the time when there would be a commercial market" (R. I, 265).

The rights of the public, the purpose of the constitutional authority to grant patents and of Congress in its legislative execution of that purpose, condemn attempts of

1. R. II, 1025 claim 89.
2. R. II, 1029 claims 90, 91, 92, 94.
3. R. II, 1035 claim 95.

alleged inventors to play fast and loose with the rights of the public and with the law. Having pointed out, when their experiments were terminated and laid aside, that they had not been satisfactory for initial starting (the *sine qua non* of an automatic choke) (R. II, 507) and having testified (R. I, 265) that "additional experimental work had to be" done, the Respondents may not now be heard to say that what the Jorgensens had then done constituted a reduction to practice. Indeed, their acts, designed to postpone to a more lucrative time the period of an intended patent monopoly, were in plain violation of the statutory law—the legal consequence of which is forfeiture of any right to a patent the applicants might otherwise have had —not a decree of approbation. *Woodbridge v. United States,* 263 U. S. 50, and *Wirebounds Patents Co. v. Saranac Automatic Mach. Corp.,* 65 F. 2d 904, vouch for that.

Moreover, the manufacture and sale for commercial use, and such use of the device (which Respondents assert, their brief p. 21, satisfies the claims here involved) with Respondents' acquiescence 5 or more years before those claims were put into the Jorgensens' application constituted, it is submitted, a disclaimer by Respondents of all rights, if any, they might have had to make those claims.

The judgments of the Court below, hence, impair the rights of the public not alone in the mere authorization of the issuance of a patent to General Motors Corporation for the claims here involved but also, as a prelude to such authorization, in their devitalization of the statutory and decisional safeguards essential to the protection of the public. Yet, those judgments of such sweeping significance rest upon meager oral evidence given long years after the alleged occurrences and in direct conflict with the explicit contemporaneous documents. Findings prepared by counsel (R. III, 1049) so refuted are of little consequence. *United States v. Gypsum Co.,* 333 U. S. 364, 394-396.

The Judgments of the Court Below Make Sterile the Doctrine of Morgan v. Daniels to the Injury of the Rights of the Public.

Verbally, the Courts below paid tribute to the doctrine of *Morgan v. Daniels*, 153 U. S. 120. But, by their rulings that the meager oral testimony (given almost 20 years after the alleged events) should outweigh the unequivocal contemporaneous documents PX 14 (R. II, 507) and PX 22 (R. II, 531) which, it is believed, evince that when the Jorgensens' experiments were laid aside there had been no reduction to practice, the Court below sterilized that doctrine and, so doing, saddled the public with a patent for the full period of 17 years, ending approximately 40 years after the Jorgensens' alleged reduction to practice.

At pages 14-15 of their Reply Brief Respondents, under the caption "Abandonment and Forfeiture" refer to that part of the Opinion filed by the Court below that says —"Soon after reducing their invention to practice they contracted to have patent applied for and for manufacture and commercial exploitation and upon failure of the other contracting party to proceed they took other steps to the same end and actually applied well within two years * * *." The asserted "other contracting party" was The Wilcolator Company (R. I, 244-246).

PX 128 and R. I, 245-246 make conspicuous the misconceptions of that statement—make clear that it is a cloth of fancy that should not be tendered to this Court as genuine. PX 128 (R. II, 703) dated April 21, 1932, recites the filing by the Jorgensens of their Patent Application S. N. 585,510 on January 8, 1932, and their assignment by an instrument of writing dated *January 6, 1932*, of their entire right, title and interest in that application to The Wilcolator Company. The instrument containing those recitals is an assignment of the application back to the Jorgensens by The Wilcolator Company. The foregoing excerpt made by Respondents from the opinion of the Court below cannot be made to square with the fore-

going contemporaneous document put in evidence by Respondents—nor with PX 14, PX 22 and Jorgensens' statement at R. I, 265. The consequences of one's deliberate efforts, in defiance of the patent statutes, to place his desired monopoly in a period believed more contributive to profits cannot be avoided by his making accusations against another.

At page 15 of their Reply Brief Respondents say that the defense of abandonment is an affirmative defense which must be pleaded and proved. That doctrine, though applicable in infringement suits, is without pertinence in actions under R. S. § 4915 (35 USC § 63). In such actions the burden is plaintiff's. The law is well established that he must prove that he is entitled to a patent. Any ground which proves that he is not defeats the suit. *Hill v. Wooster,* 132 U. S. 693; and the judgment in the *Woodbridge* case rests upon forfeiture, not abandonment.

Respondents Themselves Have Established, by Documentary Evidence, That PX 13 Should Be, and Is, Suspect.

Respondents assert that PX 13 is the *original* Stromberg carburetor experimental structure. On page 7 of their Reply Brief Respondents state:

"* * * Jorgensen produced in Court his original choke controlling mechanism physical exhibit #13, * * *."

At R. I, 228, Jorgensen testified:

"Q. Have you any particular recollection of when you got that manifold and that Stromberg carburetor as *shown on Exhibit 13*?[4]

"A. Yes, quite definitely because Mr. Kyser wrote me— * * *."

At page 20 of their Reply Brief Respondents state:

"This is not a case where we are simply relying upon oral evidence to establish Jorgensens' priority.

4. Emphasis is counsels' unless otherwise noted.

> We are relying upon a physical exhibit, Jorgensens' Ex. 13, * * *."

Apart from the fact that PX 13 is not self-proving, the documentary evidence PX 36 and DX 47 (R. II, 533) (*which was Jorgensens' Exhibit 23 in the Patent Office*) make it appear that either one or two Stromberg [5] carburetors were received by the Jorgensens. Those exhibits disclose that both, if more than one, were returned. The record discloses no evidence that either was thereafter reacquired by the Jorgensens or by General Motors Corporation.

But, what is PX 13? It is silent. It cannot speak. Respondents assert that it is the identical device with which the Jorgensens made their tests and their alleged reduction to practice. One of the elements of PX 13 is a Stromberg carburetor. When and where did it come from? PX 36 and DX 47 (Jorgensens' Exhibit 23 in the Patent Office) declare it is not the original Stromberg for those exhibits establish that the original was "Returned". PX 13, consequently seems not what Respondents have represented it to be.

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5. Jorgensen testified (R. I, 272) that the carburetor referred to in DX 47 was "*another Stromberg* carburetor, I believe identically like the original one that Kyser gave us." If that is true, one wonders why DX 47 was put in evidence in the Patent Office proceedings by the Jorgensens as their Exhibit 23! If it is not true, or even if it is uncertain that the Jorgensens had this Stromberg combination from July 16, 1930 to August 1, 1930 only, PX 13 is even more suspect. "Tests" of a choke confined to such a period and season are manifestly wholly destitute of worth.

DX 45 of December 19, 1931, (R. II, 929) confirms PX 14 in that it states respecting the test of automatic choke on Jorgensen car:

> "Started by dyn. (dynamotor) after failing to start after 1 min. cranking, choke valve would lift slightly off seat."

With respect to that Exhibit DX 45 Jorgensen said (R. I, 273):

> "It was *another unit.*"

No explanation was made by Jorgensen as to why the Jorgensens needed "another Stromberg". Jorgensen remained silent and uncorroborated as to what the "another unit" was.

DX 45 was sheet 1 dated 12-19-31 of Jorgensen's Exhibit No. 7 in the Patent Office proceedings (R. I, 427)!

It is upon such uncorroborated and unexplained testimony that respondents rely to overthrow the contemporaneous documents PX 14, PX 22, PX 128, DX 45 and DX 47 (the latter two also having been Jorgensen Exhibits in the Patent Office) and thereby to impose upon the public a new patent monopoly for the full statutory period.

Another element of PX 13 is the dash pot. Still another is a solenoid locking device. The essentiality of a dash pot, solenoid, or an equivalent as an element in the Jorgensens' experimental combination was proclaimed by Jorgensen himself in his PX 14 of August 2, 1930. Yet, the Jorgensens' Patent Application discloses no element so functioning. Respondents seek to escape their dilemma by testimony that the Jorgensens found such an element not needed. Mr. Jorgensen did so testify (R. I, 104-105, 110, 125-126, 133-134). But, he is the same Mr. Jorgensen who, at the very time the experiments were laid aside, wrote PX 14—recording the lack of success of their device without a dash pot, a solenoid or an equivalent element. It was not until 1934-1935 that the Olds device PX 41, which has no dash pot or equivalent, was produced. That was long after the respective effective dates of Ericson and Henning. But, to obtain a patent monopoly for the Olds device for the period of 17 years yet to come, Respondents seek to have the Jorgensens' experiments adjudged a reduction to practice—notwithstanding PX 14, PX 22, the testimony of Mr. Jorgensen himself at R. I, 265, and the time of their filing the claims here involved, and then to have the Olds device (which lacks an element declared "necessary" in PX 14) given an effective date as of the time of the Jorgensens' experiments. The judgments of the Court below make that plan and purpose effective. They also enable Respondents to obtain a patent monopoly for the more lucrative period—as was planned by the Jorgensens (R. I, 265).

CONCLUSION.

Could the patent statutes be so played upon by those seeking a patent monopoly, and judgments so arrived at be accepted as sound expositions of the law governing actions under R. S. § 4915 and the evaluation of evidence therein, persons unborn when an alleged reduction to practice and alleged commercial use take place would find their span of

life far gone before their payments of tribute to the monopoly so obtained would come to an end. Protection to the public under the Patent Laws would then have become largely but a memory.

Petitioners stand upon their petition and all the reasons therein relied on for the allowance of the writs.

Respectfully submitted,

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I hereby certify that 4 copies of the above Reply to Respondents' Reply Brief were mailed by me on July 19, 1950 to John H. Bruninga, 1004 Market St., St. Louis, Missouri, Attorney for Respondents.

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FILED
JUN 29 1950
CHARLES ELMORE CROPLEY
CLERK

IN THE

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1949.

No. [redacted] 74

GEORGE R. ERICSON and CARTER CARBURETOR CORPORATION,

Petitioners,

v.

CLARENCE H. JORGENSEN, CLARENCE H. JORGENSEN, Adm'r. of the Estate of Peter J. Jorgensen, Deceased, and GENERAL MOTORS CORPORATION,

Respondents.

No. 822.

OTTO HENNING and CARTER CARBURETOR CORPORATION,

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v.

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Respondents.

REPLY APPENDIX FOR RESPONDENTS.

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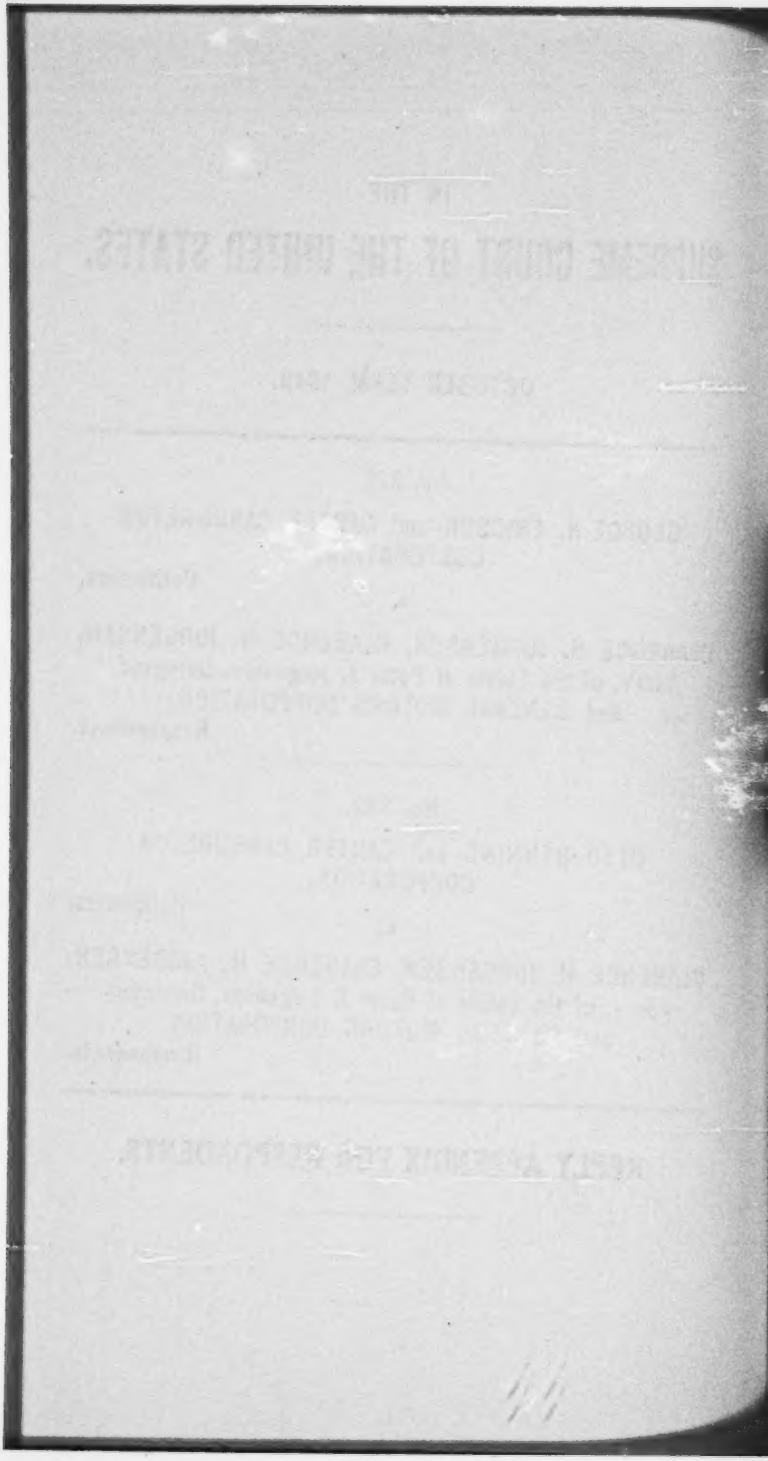

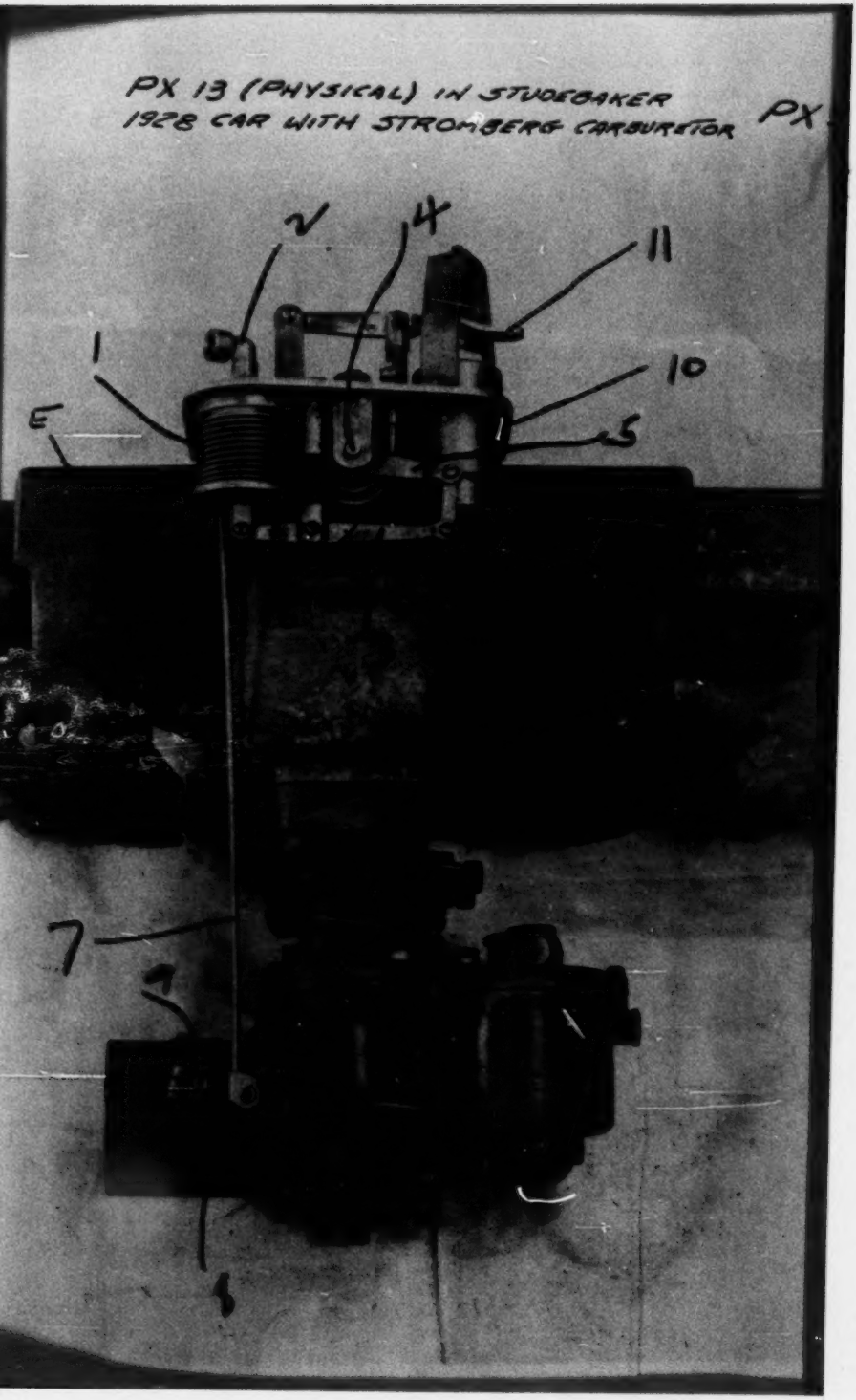
PX 13 (PHYSICAL) IN STUDEBAKER
1928 CAR WITH STROMBERG CARBURETOR
PX
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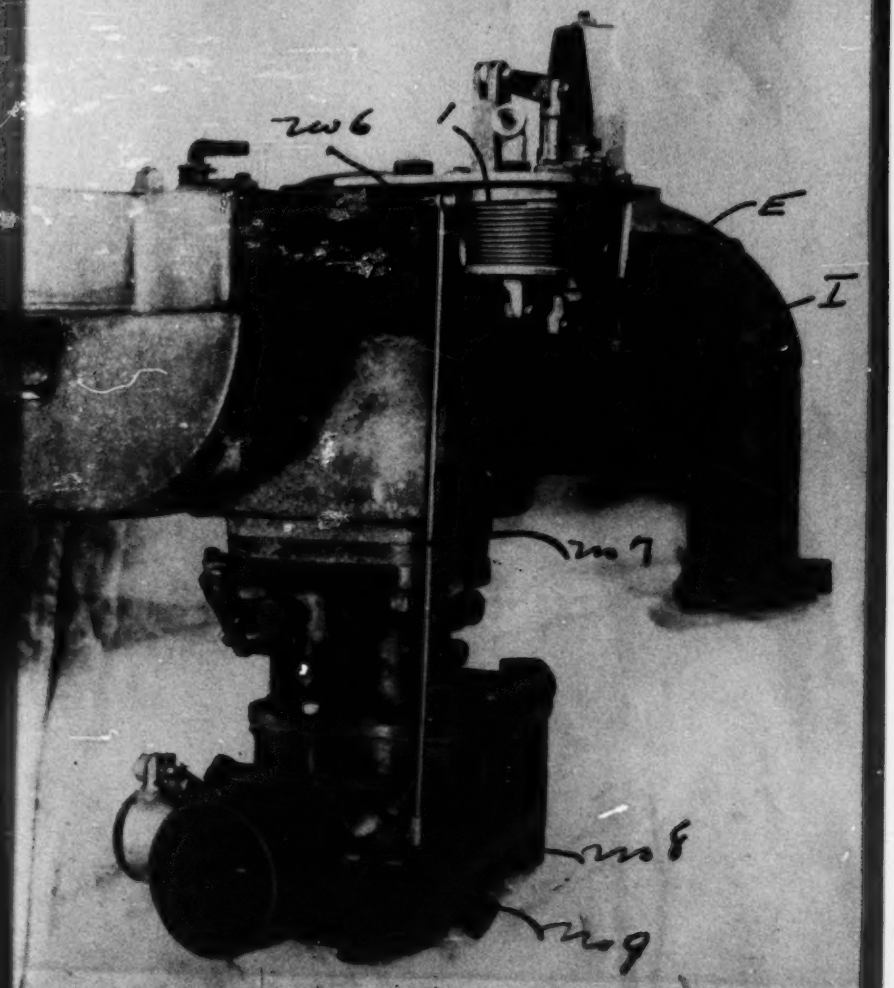
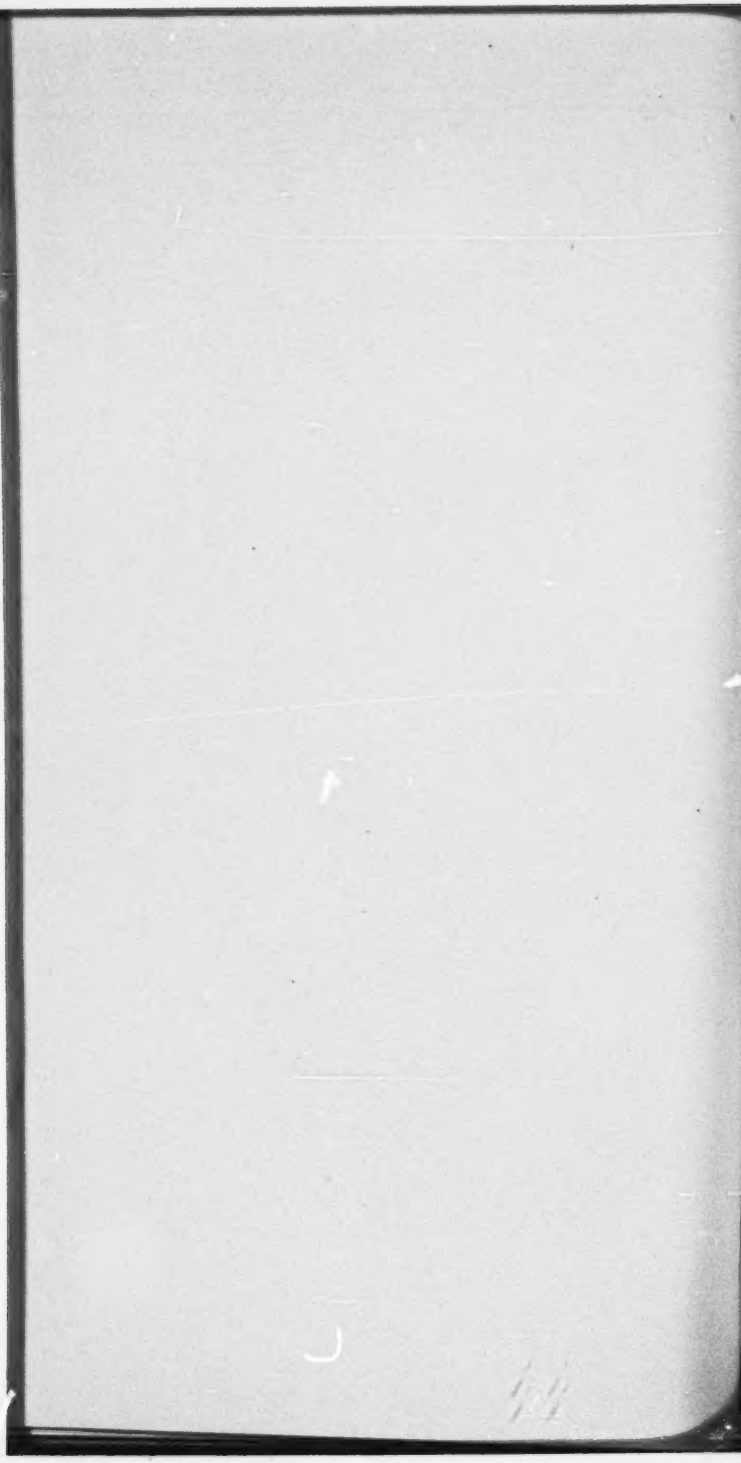
PX 13 (PHYSICAL) IN STUDEBAKER

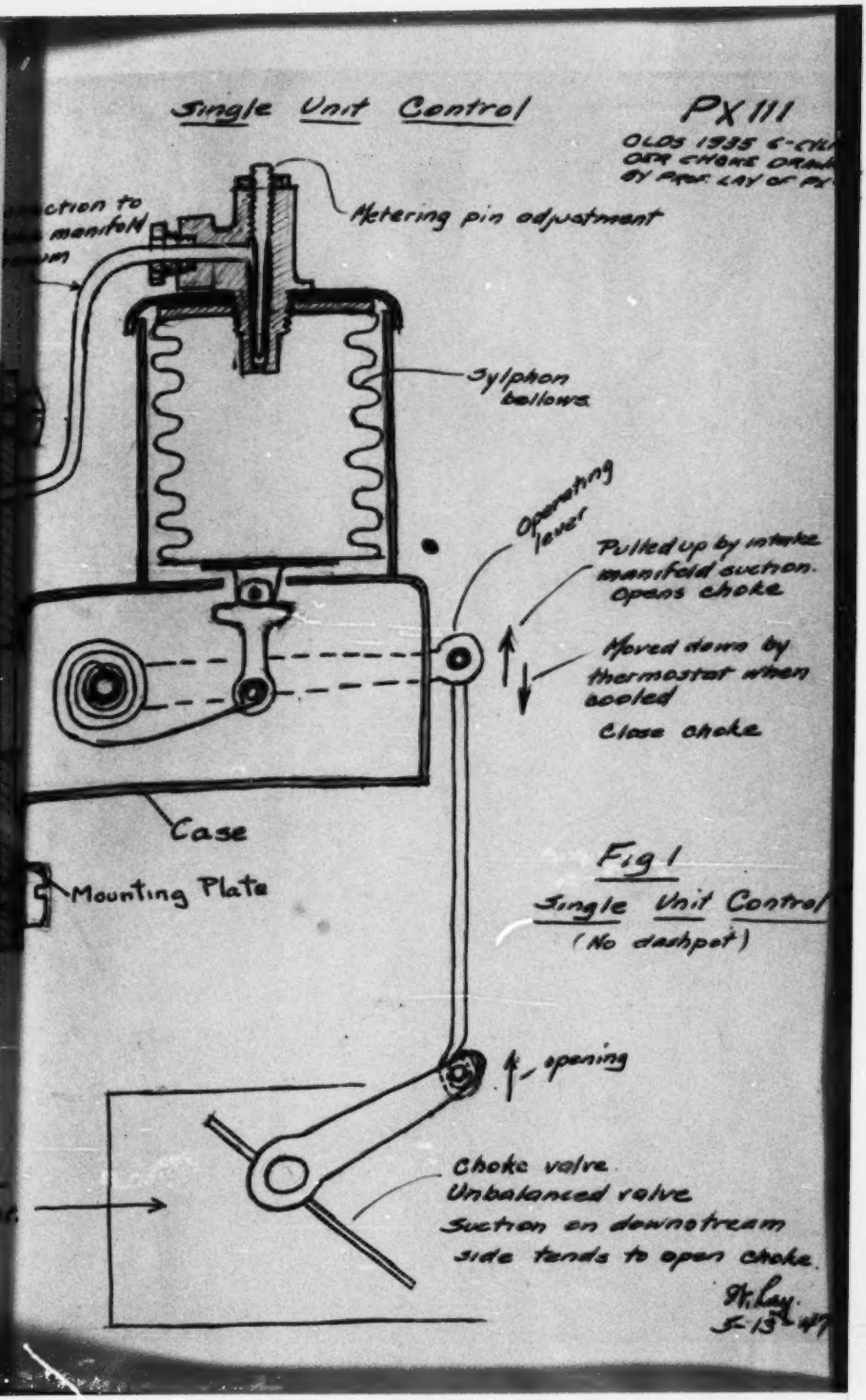
1928 CAR WITH STROMBERG CARBURETOR

PX 10



Engrav. Nos. 78346-78886-80733,
Engraving Ex No. 10.
U. S. Treaker, V. E. Fischer
Engr. Pub. Co. Montgomery Co., Pa.




Single Unit Control
PX 111
OLDS 1935 6-CYL
OTT CHOKE DRAW
BY PROF. LAY OF PU
ction to
manifold
on
Metering pin adjustment
Sylphon bellows
Operating lever
Pulled up by intake manifold suction. Opens choke
Moved down by thermostat when cooled
Close choke
Case
Mounting Plate
Fig 1
Single Unit Control
(No dashpot)
opening
Choke valve
Unbalanced valve
Suction on downstream side tends to open choke.
H. Lay
5-13-47

[fol. 114] In the District Court of the United States,
Eastern District of Missouri,
Eastern Division.

Clarence H. Jorgensen, Clarence H. Jorgensen, Adm'r, and General Motors Corporation, Plaintiffs, vs. Otto Henning and Carter Carburetor Corporation, Defendants.	Civil Action 4544 For Issuance of a Patent (R. S. 4915) Intf. 78,345
Clarence H. Jorgensen, Clarence H. Jorgensen, Adm'r, and General Motors Corporation, Plaintiffs, vs. George R. Ericson and Carter Carburetor Corporation, Defendants.	Civil Action 4545 For Issuance of a Patent (R. S. 4915) Intf. 80,733

Findings of Fact.

1. The cases are suits under Section 4915 of the Revised Statutes, 35 U. S. C. A. 63, as it existed when these suits were filed on April 30, 1946, after decisions and judgments dated Oct. 31, 1945, adverse to Plaintiffs and in favor of Defendants in Patent Office Interferences Nos. 78,345 and 80,733, respectively, awarding priority of invention to Defendants in both Interferences.[1] No appeal has been taken by Plaintiffs to the Court of Customs and Patent Appeal from either of said decisions in either of said Interferences.[2] The cases were tried together in this Court.[3]

2. Plaintiff, Clarence H. Jorgensen, is a resident of Fairport, New York, and Plaintiff, General Motors Cor- [fol. 115] poration is a Delaware corporation; Plaintiffs

1 R. II, 463, 481 2 R. I, 5, 8; 17, 20 3 R. I, 22, 57

are such in both causes Civil Action Nos. 4544 and 4545. Otto Henning, Defendant in Civil Action No. 4544, is a resident of Clayton, Missouri, George R. Ericson, Defendant in Civil Action 4545 is a resident of Kirkwood, Missouri, and Carter Carburetor Corporation, Defendant in both civil actions 4544 and 4545, is a Delaware corporation licensed to do business in Missouri and has a regular and established place of business at St. Louis, Missouri, where it maintains its general offices and factory.[1]

3. The applications of the parties were filed in the Patent Office on the following dates:

Clarence H. Jorgensen and Peter J. Jorgensen (Deceased), filed January 8, 1932, Serial No. 585,510;[2]

Otto Henning filed November 17, 1931, Serial No. 575,577;[3]

George R. Ericson, filed November 6, 1931, Serial No. 573,418.[4]

The Jorgensens' application was involved in both Interferences 78,345 and 80,733. The Henning application was involved in Interference 78,345, and the Ericson application was involved in Interference 80,733.[5]

General Motors Corporation is the owner by direct assignment of the Jorgensen application but that application is still pending. The Henning and Ericson applications were assigned to Defendant, Carter Carburetor Corporation, to whom the patents issued, as follows:

Henning Patent No. 2,421,733, granted June 3, 1947;[6]

Ericson Patent No. 1,915,851, granted June 27, 1933[7] and reissued as Re. No. 22,742 on April 9, 1946.[8]

The counts involved in the Jorgensen-Henning Interference are claims 89, 90, 91, 92 and 94 in the Jorgensen application, the first of which was introduced therein by amendment November 4, 1939 (PX 1-A, Paper No. 50),[9] and the remaining four by amendment of March 11, 1941 (PX 1-A, Paper No. 54).[10] The single count involved in the Jorgensen-Ericson Interference is claim 95 in the Jorgensen application which was added by amendment of January 27, 1943 (PX 1-A, Paper No. 60).[11]

1 R. I, 1-26
2 R. II, 931
3 R. II, 889, 905
4 R. II, 835
5 R. II, 463, 481
6 R. II, 905
7 R. II, 835
8 R. II, 863
9 R. II, 1025
10 R. II, 1029
11 R. II, 1035

[fol. 116] 4. The Complaints in each of these causes were filed on April 30, 1946;[1] the Answers in both of these causes were filed on June 20, 1946;[2] on May 28, 1947 Plaintiffs filed in each of these causes a Motion for Leave to Amend the original Complaint, which Motions were granted on May 29, 1947;[3] on June 2, 1947, Defendants filed their Answer to Plaintiffs' Amendment to Plaintiffs' Complaint in each of these causes.[4] A motion to dismiss was filed by Defendants, prior to the introduction of evidence, attacking the jurisdiction of the Court, and the Motion was taken under consideration for determination with the cases.[5]

5. These cases proceeded to trial before this Court on testimony in open Court, on certain of the depositions and parts thereof offered before the Patent Office in Interference 80,733, on Exhibits including certain of the exhibits before the Patent Office in Interference 80,733 and on the decisions of the Patent Office in Interferences 78,345 and 80,733.[6] No testimony was taken in Interference 78,345 by Defendants.[7]

6. The issues in these cases involve the question of priority of invention as between Clarence H. Jorgensen and Peter J. Jorgensen (deceased) on the one hand and Otto Henning on the other hand in Interference 78,345; and between Clarence H. Jorgensen and Peter J. Jorgensen (deceased) on the one hand and George R. Ericson on the other hand in Interference 80,733; all for the inventions defined in the counts involved in said Interferences and set out in the paragraph 9 of the Complaints. The common subject-matter of the claims embodied in the interference proceedings were determined by the Patent Office.[8]

7. The subject-matter in issue relates generally to an internal combustion engine equipped with a carburetor and with an automatic primer or choke to facilitate starting the engine and operating it before it becomes warmed up. The claims in issue are of the combination type. Some of them are to the engine-carburetor-automatic primer or choke combination and others are to the carburetor-automatic primer or choke combination.[9]

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1 R. I, 6, 18
2 R. I, 10, 23
3 R. I, 11, 24
4 R. I, 12, 25
5 R. I, 59, 424
6 R. II, 463, 481
7 R. II, 483
8 R. II, 475, 481
9 R. II, 463, 481

[fol. 117] 8. At the trial of this suit, plaintiffs introduced the testimony of Clyde R. Paton[1] and Gilbert D. Williams,[2] who testified to certain facts concerning the construction and use of the device in controversy. Their testimony was not before the Patent Office Tribunal. The witnesses were available and their testimony could have been obtained for submission to the Board; but there is no substantial suggestion that their testimony was concealed or deliberately withheld.[3] The war was on and those engaged in mechanical production were busy. Plaintiff Clarence H. Jorgensen had not talked to these witnesses for many years prior to the hearing.[4]

9. Prior to 1927 Plaintiff, Clarence H. Jorgensen and his father, Peter J. Jorgensen, who died in 1928, designed and patented primers and chokes for automobile engines and a device to control the water temperature in an automobile engine.[5] In October 1927 they constructed and applied to their Buick automobile a primer which was provided with an automatic device for supplying a rich mixture direct to the intake manifold upon starting, the rich mixture being cut off after the engine had started and had reached operating temperature.[6] This device was in operation from October 1927 until August 1928. At that time the Buick car to which the device was attached was sold and the device removed.[7] The device operated satisfactorily in cold weather during that period.[8] This device was lost after its removal from the Buick and could not be produced either at the interference hearing or at the trial of this suit.[9] It indicates the theory of the device which plaintiffs were attempting to develop. The question of whether the specific primer installed on the Buick automobile in 1927, was the sole invention of Clarence H. Jorgensen or the joint invention of the Jorgensens, was not passed upon in the decisions of the Board of Interference Examiners,[10] nor pleaded in the Defendants' Answers,[11] and cannot now be urged by the Defendants in these cases.

[fol. 118] 10. On October 20, 1928, the Jorgensens acquired a 1928 Studebaker automobile equipped with a Schebler carburetor[12] and almost immediately after receiving the

1 R. I, 317
2 R. I, 291
3 R. I, 326, 308
4 R. I, 308, 327
R. I, 221, 228
5 R. I, 182, 186, 336
6 R. I, 189-194, 337-343
7 R. I, 194; PX 5, R. II, 499
8 R. I, 194, 342
9 R. I, 194, 413-414
10 PX 1B; R. II, 463-491
11 R. I, 6, 12, 18, 25
12 PX 5, R. II, 499; R. I, 199; R. I, 346, 318

Studebaker, Jorgensen installed on it the choke-controlling mechanism identified as Plaintiffs' Exhibit 13 produced in Court[1] and comprising: (1) A heat responsive motive device in the form of a thermostat which is of spiral form and located to be heated from the exhaust manifold; (2) A suction responsive device in the form of a bellows which itself forms a spring and which is connected by pipe connection to the intake manifold so as to respond to the changes in the suction therein; (3) A joint connection from the thermostat and the bellows to the choke valve of the carburetor, viz., to the operating arm of the choke valve shaft, through a link to the end of the thermostat, through the thermostat shaft to an arm thereon and through that arm to the bellows.[2] The device so installed on the Studebaker automobile worked satisfactorily.[3] The device used upon the Studebaker automobile was again demonstrated in December 1943 in the presence of the parties to this suit in temperatures of 22° F. and proved to be satisfactory.[4] Plaintiffs' physical Exhibit 13 includes a dash pot[5] and remnant of a solenoid locking device which latter is not now connected up.[6] Originally the dash pot was connected, but later it was disconnected.[5]

11. This Court finds that the existence, construction and operation of the Jorgensens' Studebaker choke controlling mechanism, Pl. Ex. 13, including a dash pot which was originally connected but later disconnected, as applied to a 1928 Studebaker car equipped with a Schebler carburetor, was established as early as October 1928; that the mechanism so applied operated the air choke valve to secure a rich mixture at starting and with the engine cold, and with leaning out of the mixture when the engine started and further leaning out as the engine heated up;[7] [fol. 119] that the Studebaker car so equipped operated successfully in cold weather during the Winter of 1928-1929[8] and established the correctness of the principle of operation of that mechanism; and that said choke-controlling mechanism embodies the subject-matter of Count 1 set forth in paragraph 9 of the Complaint in C. A. 4545.[9]

12. Later, when the 1929 model Studebaker came out they were equipped with Stromberg carburetors, and with manifolds designed for such carburetors.[10] The Jorgensen

1 R. I, 199, 350, 319
2 R. I, 200-201, 320, 348
3 R. I, 221, 321, 354
4 R. I, 395-399
5 R. I, 204, 206, 325, 351
6 R. I, 228
7 R. I, 199, 208-213
8 R. I, 222-223, 319-321, 353-354
9 R. II, 475
10 R. I, 223-224, 347

1928 Studebaker car was equipped with such a carburetor and its manifold and their device, Plaintiffs' Exhibit 13, including a dash pot which was however disconnected, attached [ot] it; that was before Christmas 1929.[1] That device remained on the car until in July 1930, when the Jorgensens no longer had possession of the car, at which time the device was removed.[2]

13. This Court finds that the existence, construction and operation of the Jorgensens' Studebaker choke controlling mechanism Plaintiffs' Exhibit 13, including a dash pot which was however disconnected, as applied to a 1928 Studebaker car equipped with a Stromberg carburetor, was established as early as Christmas, 1929;[3] that the mechanism so applied operated the air choke valve to secure a rich mixture at starting and with the engine cold, and with leaning out of the mixture when the engine started and further leaning out as the engine heated up; that the Studebaker car so equipped operated successfully in cold weather during the Winter of 1929-1930[4] and established the correctness of the principle of operation of that mechanism; and that said choke-controlling mechanism embodies the subject-matter of Counts 1, 2, 3, 4 and 5 set out in paragraph 9 of the Complaint in C. A. 4544[5] and of Count I set forth in paragraph 9 of the Complaint in C. A. 4545.[6]

[fol. 120] 14. After July 1930 the Jorgensens had a laboratory but no manufacturing facilities, and their funds were tied up in a bank for a number of years. Automobile sales also dropped off during 1930, 1931 and 1932. In 1930 the Jorgensens contacted the Wilcolator Company and made an agreement with that company to manufacture the Jorgensen automatic choke controlling mechanism in quantities and market it, but that company had financial reversals in 1931. Jorgensen proceeded to redesign the device to get the cost down, and Jorgensen visited a number of the automobile companies in 1930 and 1931 to interest them in the device.[7] The Jorgensens' application was filed January 8, 1932.[8]

15. This Court finds with the Patent Office that Defendant, Henning, did not conceive or reduce to practice the

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1 R. I, 229, 355-356
2 R. I, 229-230, 294
3 R. I, 229, 355-356
4 R. I, 236-237, 229, 302, 356
5 R. I, 416-419
6 R. II, 475
7 R. I, 243-248
8 R. II, 931

subject-matter of Counts 1, 2, 3, 4 or 5, set forth in paragraph 9 of the Complaint in C. A. 4544 prior to the filing of his application on November 17, 1931.[1]

16. This Court finds with the Patent Office that Defendant Ericson did not actually reduce to practice the subject-matter of Count 1, set forth in paragraph 9 of the Complaint in C. A. 4545 prior to the filing of his application on November 6, 1931;[2] that Defendant Ericson conceived the subject-matter of said Count 1 after said Jorgensens had conceived and reduced to practice the subject-matter of said Count 1; and that any conception by Ericson of the subject-matter of said Count 1 in the fall of 1929, given by the Patent Office,[3] is unimportant.

[fol. 121] 17. The dash pot on Plaintiffs' physical Exhibit 13 was identified by Plaintiff Jorgensen and by Plaintiffs' Witnesses Paton and Kyser.[4] Plaintiffs' Witness Williams recognized the dash pot but was not familiar with its action.[5] The dash pot was originally connected when the mechanism was used with the Schebler carburetor but it was later disconnected when the mechanism was used with either the Schebler or with the Stromberg carburetor. The dash pot was not needed on the mechanism when used with either a Schebler or a Stromberg carburetor.[6] A solenoid locking device referred to by Jorgensen was an experimental unit placed on the intake of the carburetor; it was not originally put on Plaintiffs' Exhibit 13 but at a later date and then for a very short time because not needed; it is not connected up in Plaintiffs' Exhibit 13; the witnesses other than Jorgensen did not identify such a solenoid locking device.[7]

18. The Jorgensens had given an automatic choke study for a number of years and were jointly working along that line. What they were trying to do was to find means that would serve the requirements necessary to start and to run an automobile engine, particularly when cold, entirely automatically. The early part of 1927 they felt that they had the necessary requirements in mind that would make it possible to make a fully automatic choke, sensing the difference between cranking and running,

1 R. II, 483
2 R. II, 477
3 R. II, 477
4 R. I, 203-207, 324-325, 350-351
5 R. I, 310
6 R. I, 204-206, 324-325, 350-351
7 R. I, 228

by employing a suction device and a thermostatic metal to control or modify either the fuel or the air side of the carburetor.[1]

[fol. 122] Conclusions of Law.

I. This is a suit under R. S. 4915, 35 U. S. C. A. 63, and this Court had jurisdiction of the subject-matter and of the parties.

II. In this suit under Section 4915 of the Revised Statutes, 35 U. S. C. A. 63 as it existed when these suits were filed on April 30, 1946, the issue is one to determine the question of priority of invention as between Plaintiffs and Defendants.

III. The allegations of the original Complaints clearly stated a cause of action, the jurisdiction of which was in the District Court. It was unnecessary for the pleader, in referring to Title 35, Section 63, U. S. C. A. (Rev. Stat. 4915), to add the explanatory words as to when the act had been amended. It was not necessary to confer jurisdiction on the Court to mention the section of the statute under which it was brought. It was not necessary for the pleader to quote the words of the statute providing when suit may be brought by an applicant who had been denied a patent. The amendments to the Complaints were unnecessary, but having been made, they simply stated more clearly and spelled out in greater detail that which was already sufficient. The motion of the defendants to dismiss for lack of jurisdiction is overruled.

IV. In this suit under R. S. 4915 it was not necessary that all nor any of the evidence before the Patent Office [fol. 123] be presented to this Court. It was the intent of Congress that the parties might introduce the whole or any part of the evidence heard by the Patent Office Tribunal for consideration and it is to be given "the same force and effect as if originally taken and produced in the suit." (Chapter 273, Sec. 11, 44 Stat. 1336, March 2, 1927.) The right is given to the parties to take further testimony, unless the withholding of the evidence before

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1 R. I, 187-189

the Patent Office was willful or was concealed or deliberately withheld. There was no such withholding or concealment and the contention of Defendants in that respect is overruled.

V. This Court concludes that the Jorgensens' Studebaker choke controlling mechanism, Plaintiffs' physical Exhibit No. 13, combined with a Stromberg carburetor on a 1928 Studebaker car, constituted before Christmas 1929 and during the Winter of 1929-1930, a conception and reduction to practice of that combination and of the subject-matter of Counts 1, 2, 3, 4, and 5 as set forth in paragraph 9 of the Complaint in Civil Action 4544.

VI. This Court concludes that the Jorgensens' Studebaker choke controlling mechanism, Plaintiffs' physical Exhibit No. 13 in combination with a Schebler carburetor on a 1928 Studebaker car, constituted in October 1928 and during the Winter of 1928-1929 and until Christmas 1929, and in combination with a Stromberg carburetor on such a car, before Christmas 1929 and during the Winter of 1929-1930, conceptions and reductions to practice of those combinations and of the subject-matter of Count 1 as set forth in paragraph 9 of the Complaint in Civil Action 4545.

VII. This Court concludes that Defendant, Henning did not conceive or reduce to practice the subject-matter of Counts 1, 2, 3, 4 and 5 as set forth in paragraph 9 of [fol. 124] the Complaint in C. A. 4544 before he filed his application on November 17, 1931, or before Clarence H. Jorgensen and Peter J. Jorgensen, conceived and reduced to practice the subject-matter of said Counts.

VIII. This Court concludes that Defendant, Ericson, did not conceive or reduce to practice the subject-matter of Count 1 set forth in paragraph 9 of the Complaint in C. A. 4545 before Clarence H. Jorgensen and Peter J. Jorgensen conceived and reduced to practice the subject-matter of said Count.

IX. This Court concludes that Clarence H. Jorgensen and Peter J. Jorgensen are the original, first and joint in-

ventors of the subject-matter of Counts 1, 2, 3, 4 and 5 set forth in Paragraph 9 of the Complaint in Civil Action 4544, and of Count 1 set forth in paragraph 9 of the Complaint in Civil Action 4545.

X. This Court concludes that Clarence H. Jorgensen and Peter J. Jorgensen having reduced to practice the subject-matter of the Counts set forth in [paragraphs] 9 of the Complaint, were not required to be diligent in the filing of their application.

XI. Plaintiffs are entitled to an award of priority of the Counts 1, 2, 3, 4 and 5 set forth in Paragraph 9 of the Complaint in Civil Action 4544, and of Count 1 set forth in Paragraph 9 of the Complaint in Civil Action 4545, and the Commissioner of Patents is authorized to issue such patent to Plaintiffs upon filing in the Patent Office copy of the adjudication and otherwise complying with the requirements of law.

XII. Plaintiffs are entitled to their costs and disbursements in this proceedings.

Feb. 11, 1949.

R. M. DUNCAN,
United States District Judge.